

### REMARKS

Applicant has reviewed and considered the Office Action mailed on February 28, 2003, and the references cited therewith.

Claim 29 is amended; no claims are canceled or added; as a result, claims 1-12 and 19-29 remain pending in this application. The amendment to claim 29 corrects a minor typographical error and is not in response to an art based rejection.

#### §103 Rejection of the Claims

Claims 1-12 and 19-29 were rejected under 35 USC § 103(a) as being unpatentable over Schein (US 6,002,394) in view of Kostreski et al. (US 5,734,589). In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection because cited references do not teach each and every element of Applicant's claims.

An example of an element not found in the cited references is found in independent claim 1, which recites a system that "automatically adds each of the logical channels to the favorite channel list without user intervention". Similar language is recited in independent claims 8, 19, 24 and 25. The Office Action asserts that Schein, at column 16, lines 25-35, teaches the recited language. Applicant respectfully disagrees with this interpretation of Schein. The cited language discloses adding programs to a selection window that have criteria that match a program designated as a favorite. However, clearly the selection window is different from the favorites list. Schein discloses a favorites list at column 10 lines 40-58. The favorites list of Schein is a list of channels. The selection window of Schein includes a set of programs, not

channels. As a result, the selection window cannot be the same as the favorites list. Therefore, Schein does not teach or disclose adding logical channels to a favorites list as recited in Applicant's claims. Additionally, Applicant has reviewed Kostreski and can find no teaching of automatically adding logical channels to a favorites list. Thus neither Schein nor Kostreski teach each and every element of Applicant's claims 1, 8, 19, 24 and 25. Applicant respectfully requests the withdrawal of the rejection of claims 1, 8, 19, 24 and 25.

Claims 2-7, 9-12, 20-23 and 26-29 depend from base claims 1, 8, 19 and 25 respectively. They are therefore non-obvious for the reasons discussed above with respect to their base claims, in addition to adding further patentable distinctions. Applicant respectfully requests the withdrawal of the rejection of claims 2-7, 9-12, 20-23 and 26-29.

Additionally, claims 20, 21, 26 and 27 each recite the use of a sub-theme to identify channels to add to the favorites list. Applicant can find no teaching or disclosure of a sub-theme used to identify favorite channels in either Schein or Kostreski. Applicant respectfully requests the withdrawal of the rejection of claims 20, 21, 26 and 27.

Moreover, claims 22 and 28 recite that "the logical channels identified during the step of identifying depend on an update frequency of the EPG content database and a number of time slots included in the favorite channels list". The Office Action rejects claims 22 and 28 by referring to the analysis of claim 2. However, claim 2 does not recite an update frequency nor does claim 2 refer to the number of time slots in the favorite channel list. Therefore, the analysis of claim 2 in the Office Action does not apply to claims 22 and 28. Additionally, Applicant has reviewed Schein and Kostreski and can find no teaching or disclosure of the recited language. Applicant respectfully requests the withdrawal of the rejection of claims 22 and 28.

Furthermore, in the response to Applicant's arguments, the Office Action cites three U.S. patents 6,075,526, 6,408,437 and 6,078,348 and asserts that the functions "automatically adding" and "without user intervention" are notoriously well known in the art. However these references are not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form part of future rejections.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

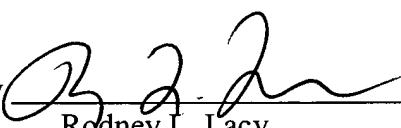
Respectfully submitted,

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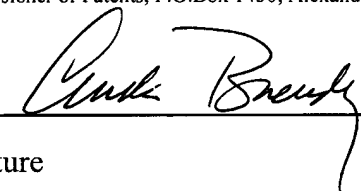
Date May 28, 2003

By   
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Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 28TH day of May, 2003.

Candis B. Buending

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